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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Dated: March 3, 2006

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and DUSTIN C. ROSING

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Examiner B. Pesin

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Alexandria, Virginia 22313-1450

Sir:

**AMENDED BRIEF OF APPELLANTS**

This Amended Brief of Appellants is presented in opposition to the Examiner's final rejection of claims 1-23 in the Office action dated December 15, 2004. Pursuant to the Office communication dated February 24, 2006, this Amended Brief of Appellants includes a section entitled "Evidence Appendix", and is intended to replace the Brief of Appellants filed April 7, 2005.

**I. REAL PARTY IN INTEREST**

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

**II. RELATED APPEALS AND INTERFERENCES**

There are no known related appeals or interferences.

**III. STATUS OF CLAIMS**

Claims 1-23 have been presented and are currently pending in the application.

Applicants appeal the final rejection of claims 1-23.

**IV. STATUS OF AMENDMENTS**

No amendments have been made subsequent to the Office action dated December 15, 2004.

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

Claim 1 recites a method for accessing instructions on a device having a user interface. The method includes receiving a user-selection of a first help mode displayed on the user interface, the selected first help mode allowing the user to choose an icon for identification of a function associated with the icon without invoking the function (page 4, line 24 to page 5, line 10; Figs. 2, 4 and 5), and upon receiving a user-selection of the icon, displaying a help window including an identification of a function associated with the icon and a link to instructions related to accomplishing the function (page 5, lines 11-20; Figs. 2 and 6). The method further includes displaying the instructions related to accomplishing the function in response to user-selection of the link (page 5, lines 20-28; Figs. 2 and 7).

Claim 6 recites a device configured to perform one or more user-selectable functions. The device includes a processor configured to nominally effect a function upon receiving a command associated with the function (page 3, line 25 to page 4, line 9; Figs. 1 and 2), and a user interface (page 4, lines 3-23; Fig. 3). The user interface includes a plurality of selectable icons, selection of each icon nominally

effecting transmission of a corresponding command to the processor (page 3, line 25 to page 4; line 23, Figs. 1-3). The user interface further includes a help menu having a user-selectable first help mode which provides for subsequent selection of icons without transmission of the corresponding command to the processor (page 4, line 24 to page 5, line 4, Figs. 2 and 4), and a help window presented upon selection of an icon after selection of the first help mode (page 5, lines 5-12, Figs. 2, 5 and 6). The help window includes an identification of a function associated with the selected icon and a link to command instructions related to the function associated with the selected icon (page 5, lines 12-20; Figs. 2 and 6), where selection of the link effects communication of the instructions (page 5, lines 20-28; Figs. 2 and 7).

Claim 14 recites a computer-implemented user interface. The computer-implemented user interface includes plural icons, each nominally selectable to invoke a function associated with the icon (page 3, line 25 to page 4; line 23, Figs. 1-3), and a help menu having a first help mode selectable to provide for subsequent selection of one of the icons without invoking the function associated with the selected icon (page 4, line 24 to page 5, line 4, Figs. 2 and 4). The computer-implemented user interface further includes a help window presented upon selection of the first help mode and subsequent selection of the selected icon (page 5, lines 5-12, Figs. 2, 5 and 6), the help window including an identification of the function associated with the selected icon and a link to command instructions related to the function associated with the selected icon (page 5, lines 12-20; Figs. 2 and 6). The computer-implemented user interface further includes command instructions presented upon selection of the link (page 5, lines 20-28; Figs. 2 and 7).

Claim 21 recites a program storage device readable by a processor, tangibly embodying a program of instructions executable by the processor to perform method steps for accessing instructions on a device having a user interface. The method performed by the program storage device includes receiving a user-selection of a first help mode displayed on the user interface, the selected first help mode allowing the user to choose an icon for identification of a function associated with the icon without invoking the function (page 4, line 24 to page 5, line 10; Figs. 2, 4 and 5). The method performed by the program storage device further includes displaying a help window upon receiving a user-selection of the icon, where the help window includes an identification of a function associated with the icon and a link to instructions related to accomplishing the function (page 5, lines 11-20; Figs. 2 and 6). The method performed by the program storage device further includes displaying the instructions related to accomplishing the function in response to user-selection of the link (page 5, lines 20-28; Figs. 2 and 7).

Specific references to portions of the application are provided with the understanding that nonreferenced portions of the application may also be relevant. As such, it should be understood that the claims are not limited by the particular references made above, but rather are fully supported by the entirety of the disclosure.

## **VI. GROUNDS OF REJECTION**

In the Official action of December 15, 2004:

Claims 1-8, 14-15, and 21-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Microsoft Word (“MS Word”) Screen Dumps, pages 1-5 (1999 version).

Claims 9-13 and 16-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over MS Word Screen Dumps, pages 1-5 (1999 version) in combination with Fang (US 6,628,311).

## **VII. ARGUMENT**

### ***A. Rejection of Claims 1-8, 14-15, and 21-23 under 35 U.S.C. § 103(a) as Being Unpatentable over the MS Word Screen Dumps is Inappropriate***

The Examiner rejected claims 1-8, 14-15, and 21-23 as being obvious over the MS Word Screen Dumps, pages 1-5. Applicants assert that the Examiner has failed to establish the *prima facie* obviousness of claims 1-8, 14-15, and 21-23.

#### ***1. The Legal Standard***

Obviousness is a question of law based on (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness.

*Graham v. John Deere Co.*, 383 U.S. 1, 17 (US 1966). “In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art.” *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). “If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

*In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991).

2. Claim 1-5

Claim 1 recites a method for accessing instructions on a device having a user interface. The claimed method includes "receiving a user-selection of a first help mode displayed on the user interface, the selected first help mode allowing the user to choose an icon for identification of a function associated with the icon without invoking the function," and "upon receiving a user-selection of the icon, displaying a help window including an identification of a function associated with the icon and a link to instructions related to accomplishing the function." The claimed method also includes "in response to user-selection of the link, displaying the instructions related to accomplishing the function." The Examiner rejected Claim 1 as being obvious over the MS Word Screen Dumps.

As understood from the MS Word Screen Dumps, pages 1-5 (Figs. 1-9), MS Word is a word-processing program having a drop down help menu. The help menu includes a “What’s This?” tool, as shown in Fig. 2 of the MS Word Screen Dumps. Upon selection of the “What’s This?” tool, an icon may be identified by passing a cursor over the icon, and the function performed by that icon is identified in a pop-up window, as shown in Figs. 3 and 4. As previously asserted on page 8, paragraph 4 of applicants’ response dated August 3, 2004, it is unclear from the MS Word Screen Dumps whether the icon is identified by a mouse-click, or simple placement of the cursor over the icon. It is also unclear from the MS Word Screen Dumps whether the icon functions are disabled upon selection of the “What’s This?” tool, or are possibly still effected by mouse-click, double-mouse-click, etc. However, Figs. 3 and 4 of the MS Word Screen Dumps clearly show that the pop-up window provided by the “What’s This?” tool does not include a link to instructions related to accomplishing the function. This fact is expressly recognized by the Examiner on page 2, paragraph 3 of the Office action dated May 7, 2004, and again on page 3, paragraph 2 of the Office action dated December 15, 2004.

In addition to the “What’s This?” tool, the MS Word Screen Dumps also disclose a “Microsoft Word Help” tool (“MS Word Help” tool”), previously referred to as a Table of Contents (TOC) tool. (See, e.g., page 9, paragraph 2 of applicants’ response dated August 3, 2004, and page 9, paragraph 3 of the Office action dated December 15, 2004). The “MS Word Help” tool provides a searchable database of topics for which help is available. Upon selection of the “MS Word Help” tool (as shown in Fig. 5), a window appears that includes a search field, a search results field, and a help window (as shown in Figs. 6-9). A user may enter a search term for which they would like help

into the search field, such as the term “safeguard” shown in Fig. 6 of the MS Word Screen Dumps, or the term “format” shown in Figs. 7-9 of the MS Word Screen Dumps. Help topics related to the search term are then displayed in the search results field. A user may select a particular topic for which they would like help, such as “Troubleshoot borders,” or “Apply a language format to text in a document.” As shown in Fig. 6 of the MS Word Screen Dumps, a list of subtopics, related to the selected topic, may then be displayed in the help window, where each subtopic addresses a particular word processing task that a user is having trouble performing. Presumably, one or more of these subtopics may then be selected by the user based on the particular word processing task for which they would like to receive help. Selection of a topic from the search results field alternatively may provide some instructions on how to perform a particular word processing task, with links to additional instructions related to performing the word processing task, as shown in Figs. 7-9 of the MS Word Screen Dumps. Figs. 5-9 of the MS Word Screen Dumps do not show any instructions related to icons identifiable via the “What’s This?” tool, nor do they show any step by step instructions related to performing the function associated with such icons. (See applicants’ argument presented on page 9, paragraph 2 of applicants’ response dated August 3, 2004).

In rejecting claim 1, the Examiner asserted that:

“the MS Word “What’s This?” tool teaches a method for accessing instructions on a device having a user interface, the method comprising the steps of: receiving a user-selection of a first help mode displayed on the user interface (page 1, figure 2 [of the MS Word Screen Dumps]), the selected first help mode allowing the user to choose an icon for identification of a function associated with the icon without invoking the function (page 2, figure 3 [of the MS Word Screen Dumps]); upon receiving a user-selection of the icon, displaying a help window including an identification of a function associated with the icon (page 2, figure

3 [of the MS Word Screen Dumps]). The MS Word ‘What’s This’ tool does not disclose a link to instructions related to accomplishing the function; and in response to user-selection of the link, displaying the instructions related to accomplishing the function.

The MS Word Help tool teaches a link to instructions related to accomplishing the function (page 4, figure 7 [of the MS Word Screen Dumps]); and in response to user-selection of the link, displaying the instructions related to accomplishing the function (pages 4-5, figures 8-9 [of the MS Word Screen Dumps]).” (Page 3, paragraphs 2 and 3 of the Office action dated December 15, 2004).

The Examiner also asserted that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to include a link to instructions related to a function and in response to user selection of the link displaying the instructions, as taught by the MS Word Help tool, with the motivation to reduce the number of steps required to access help information.” *Id.*

Applicants traverse this rejection, and assert that the Examiner has failed to establish a *prima facie* case of obviousness, because: (1) the MS Word Screen Dumps do not clearly disclose a method for accessing information that includes a first help mode that allows a user to choose an icon for identification of a function associated with the icon without invoking the function; (2) the MS Word Screen Dumps do not disclose a method for accessing information that includes displaying instructions related to accomplishing the function associated with an icon identifiable with the first help mode; (3) the MS Word Screen Dumps do not teach or suggest modifying the MS Word “What’s This?” tool to include a link to instructions related to accomplishing the function of an icon identifiable with the “What’s This?” tool, and (4) the Examiner has proposed a modification that changes the principle of operation of the “MS Word Help” tool.

The MS Word Screen Dumps do not clearly disclose a method for accessing information including a help mode that allows a “user to choose an icon for identification of a function associated with the icon without invoking the function,” as claimed in claim 1. Specifically, Figs. 2 and 3 of the MS Word Screen Dumps do not clearly show whether the icon is identified by a mouse-click, or simple placement of the cursor over the icon. Figs. 2 and 3 of the MS Word Screen Dumps also do not clearly show whether the icon functions are disabled upon selection of the “What’s This?” tool, or are possibly still effected by mouse-click, double-mouse-click, etc.

On page 7 of the Office action dated December 15, 2004, the Examiner considered applicants’ argument that the MS Word Screen Dumps do not clearly show whether the icon is identifiable by a mouse-click or simple placement of the cursor over the icon. In response, the Examiner asserted that “the icon is identifiable by both, hovering over the icon and by pressing the mouse button. If one hovers over the icon a short description of the button appears. If one clicks on the button a more detailed description appears.” (Page 8, paragraph 3 of the Office Action dated December 15, 2004).

However, the Examiner has still not disclosed sufficient evidence to clarify how the “What’s This?” tool functions. Although Figs. 2 and 3 of the MS Word Screen Dumps show pop-up windows including an identification of a function associated with an icon, the Examiner has not disclosed whether this pop-up window provides a “short description of the button” that appears “if one hovers over the icon,” or “a more detailed description” that appears “if one clicks on the button.” If the pop-up windows shown in Figs. 2 and 3 provide “a short description of the button,” then presumably “a more detailed description of the button” would also identify a function associated with the icon

(i.e. any user selection would identify a function associated with the icon). However, if the pop-up windows show a “detailed description of the icon,” then it is impossible for applicants to determine whether the “short description of the button” provides sufficient information for “identification of a function associated with the icon.” This distinction is relevant to the discussion below.

On page 7 of the Office action dated December 15, 2004, the Examiner also considered applicants’ argument that the MS Word Screen Dumps do not clearly show whether the icon functions are disabled upon selection of the “What’s This?” tool, or are possibly still effected by mouse-click, double-mouse-click, etc. In response, the Examiner asserted that “the icon is disabled after the user presses the ‘What’s This?’ button. The icon is disabled so that a user can press the mouse button and get a detailed description of the button and not activate the normal use of the button.” (Page 8, paragraph 4 of the Office action dated December 15, 2004).

The Examiner, however, has failed to provide sufficient evidence to show that the icon is disabled upon selection of the MS Word “What’s This?” tool, such that a user can press the mouse button and get a detailed description of the icon without activating the normal function of the icon. Specifically, the MS Word Screen Dumps do not clearly show: (1) whether the pop-up windows shown in Figs. 2 and 3 of the MS Word Screen Dumps provide a “short description,” that appears by hovering the cursor over the icon, or “a more detailed description” that appears by pressing the mouse button (as discussed above); (2) whether hovering over the icon, pressing the mouse button, or double-clicking the mouse button, thereafter disables the “What’s This?” tool and enables the icon, or (3) whether the icon’s function is, in fact, disabled after pressing the “What’s This?” tool. For example, Fig. 3 shows a pop-up window that

provides a description of the “Bold” icon. However, it is impossible from Fig. 3 to determine whether the pop-up window appeared as a result of hovering the cursor over the icon, or pressing the mouse button. If the pop-up window appeared as a result of hovering the cursor over the icon, it is impossible from Fig. 3 to determine whether the “What’s This?” tool has been disabled after hovering over the icon, such that the icon’s function may be enabled by simply pressing the mouse button. Even if the pop-up window appeared as a result of pressing the mouse button, it is impossible to determine whether the function of the “Bold” icon was disabled, because there is no text selected in the word processing window that would have been given “Bold” type if the icon’s function had been enabled. Therefore, the Examiner has failed to show a help mode that allows a user to choose an icon for identification of a function associated with the icon without invoking the function, and the rejection of claim 1 should be withdrawn.

The MS Word Screen Dumps also do not disclose a method for accessing information that includes displaying instructions related to accomplishing the function associated with an icon identifiable with a first help mode, as claimed in claim 1. As discussed above, Figs. 6-9 of the MS Word Screen Dumps do not show any instructions related to icons identifiable via the “What’s This?” tool, nor do they show any step by step instructions related to performing the function associated with such icons.

On page 7 of the Office action dated December 15, 2004, the Examiner considered applicants’ argument that the MS Word Screen Dumps do not clearly show whether the instructions obtained from the “MS Word Help” tool are in any way related to the icons identifiable via the “What’s This?” tool, or whether such instructions relate

to any type of function associated with such icons. In response, the Examiner merely asserted that:

“the [“MS Word Help” tool] of the MS Word screen shots correlate to the selectable icons. The [“MS Word Help” tool] includes more information than just for the icons, but it does have information on the icons.” (page 9, paragraph 3 of the Office action dated December 15, 2004).

The Examiner, however, has failed to provide sufficient evidence to show that the help topics of the “MS Word Help” tool correlate to the function of the icons identifiable via the “What’s This?” tool. Specifically, Figs. 6-9 of the MS Word Screen Dumps show pop-up windows that include a search field, a search results field, and a help window. None of the help topics listed in either the search results field or the help window of Figs. 6-9 appear to provide any instructions related to icons identifiable via the “What’s This?” tool, let alone instructions related to any type of function associated with such icons. Therefore, the Examiner has failed to show a method of accessing information including displaying instructions related to accomplishing the function of an icon identifiable with a first help mode, and the rejection of claim 1 should be withdrawn.

The MS Word Screen Dumps do not disclose “a help window including an identification of a function associated with the icon and a link to instructions related to accomplishing the function,” as claimed in claim 1. In fact, even if the Examiner’s asserted functions of the “What’s This?” tool and “Microsoft Word Help” tool are accepted based on the MS Word Screen Dumps, the Examiner has explicitly recognized that the “MS Word ‘What’s This?’ tool does not disclose a link to instructions related to accomplishing the function; and in response to user-selection of the link, displaying the instructions related to accomplishing the function.” (Page 3, paragraph 2 of the Office action dated December 15, 2004). Further, applicants assert that there is no suggestion or motivation expressed in the cited art to modify

the “What’s This?” tool to include the function of the “MS Word Help” tool. The rejection of claim 1 under 35 U.S.C. § 103(a) thus should be withdrawn.

To establish a *prima facie* case of obviousness, all claim features must be taught or suggested by the prior art. Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990). The motivation or suggestion to combine may come from the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). The teaching or suggestion must be found in the prior art, and not in the applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1988).

In rejecting claim 1, the Examiner acknowledged that the “What’s This?” tool illustrated in the MS Word Screen Dumps does not include a link to instructions related to accomplishing the function associated with the icon. (Page 3, paragraph 2 of the Office action dated December 15, 2004). However, the Examiner asserted that it would be obvious “to modify the teachings of the MS Word ‘What’s This?’ tool to include a link to instructions related to a function and in response to user selection of the link displaying the instructions, as taught by the ‘MS Word Help’ tool.” (Page 3, paragraph 3 of the Office action dated December 15, 2004). The Examiner indicated that motivation for such a modification would be “to reduce the number of steps required to access help information,” which is “knowledge generally available to one of ordinary skill in the art.” (Page 9, paragraph 1 of the Office action dated December 15, 2004).

The Examiner has not factually supported a *prima facie* conclusion of obviousness because the Examiner has not identified a proper teaching or suggestion to modify the MS Word “What’s This?” tool. To the contrary, the Examiner concludes, without factual support, that reducing the number of steps required to access help information is knowledge generally available to one of ordinary skill in the art. However, none of the art cited by the Examiner discusses or suggests reducing the number of steps required to access help information. Instead, accessing help information via the “MS Word Help” tool alone requires as many as five independent steps. Several of these steps may require a reasonable degree of knowledge or technological competence on the part of the user to navigate the “MS Word Help” mode. For example, as shown in Fig. 6-9 of the MS Word Screen Dumps, a user must: (1) click on the pull down help menu; (2) select the “MS Word Help” tool; (3) formulate a search term to provide a search query and type the search term into the search field; (4) read through the search results and select a help topic; and (5) read through the help provided in the help window and select links to subtopics or links to additional information. This litany of user input does not demonstrate that those skilled in the art (i.e. the software engineers of MS Word) were motivated to reduce the number of steps required to access help information. Rather, it appears to demonstrate a motivation to provide as many help topics as possible for performing a given word processing task. The Examiner apparently is using the applicants’ disclosure, which does describe the desire to reduce the number of steps required to access help information, as a template for modifying MS Word. This is inappropriate because the motivation or suggestion to make the combination can not come from the disclosure of the applicant. *In re Vaeck*, 947 F.2d

488 (Fed. Cir. 1991). The proposed modification is therefore improper, and the rejection of claim 1 should be withdrawn.

Further, even if the "What's This?" tool and the "MS Word Help" tool were combined in a single help window, which applicants maintain is improper, the combination would not result in a one-to-one relationship between (1) identification of a function associated with an icon, and (2) instructions related to accomplishing the function associated with the icon. As shown in Fig. 6 of the MS Word Screen Dumps, the "MS Word Help" tool provides a window that includes: a search field for typing a search term; a search results field for displaying a list of topics related to the search term; and a help window for displaying a list of subtopics related to a selected topic, or for displaying information for performing a given word processing task with links to additional information related to that task. Providing a "What's This?" tool with a link to the "MS Word Help" tool would simply allow searching of help topics from within the "What's This?" tool. Despite the Examiner's assertion to the contrary, it is not even clear from the MS Word Screen Dumps that the help topics in the "MS Word Help" tool correlate to the selectable icons, or the functions associated therewith. For these reasons also, the rejection of claim 1 should be withdrawn.

On page 7 of the Office action dated December 15, 2004, the Examiner considered applicants' argument that combining the "What's This?" tool and the "MS Word Help" tool would not result in a one-to-one relationship between (1) identification of a function associated with an icon, and (2) instructions related to accomplishing the function associated with the icon. In response, the Examiner asserted that combining the "MS Word Help" tool and the "What's This?" tool "would result in a one-to-one relationship because the combination would allow the ["MS Word Help" tool] to open

showing detailed instructions related to accomplishing the function associated with an icon." (Page 9, paragraph 2 of the Office action dated December 15, 2004).

The Examiner has proposed a modification that changes the principle of operation of the "MS Word Help" tool. The "MS Word Help" tool is a search tool. The Examiner proposes modifying the "MS Word Help" tool to have it automatically access a predetermined help topic. If the modification proposed by the Examiner changes the principle of operation of the prior art invention being modified, then the teaching of the reference is not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959). Further, the Examiner again appears to be using the applicants' disclosure as a template for modifying MS Word. This is inappropriate because the motivation or suggestion to make the proposed modification can not come from the disclosure of the applicant. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The proposed modification is therefore improper, and the rejection of claim 1 should be withdrawn.

If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending from that claim is also nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, claims 2-5 are nonobvious because they depend from nonobvious claim 1.

### 3. Claims 6-8

Claim 6 recites a device configured to perform one or more user-selectable functions. The device includes a user interface with plural selectable icons, "selection of each icon nominally effecting transmission of a corresponding command to the processor" and a help menu with a user-selectable first help mode "which provides for subsequent selection of icons without transmission of the

corresponding command to the processor.” Claim 6 also includes a help window that identifies “a function associated with the selected icon” and “a link to command instructions related to the function associated with the selected icon, selection of the link effecting communication of the instructions.”

The Examiner indicated that claim 6 is “similar in scope to claim 1, and [is] therefore rejected under similar rationale.” (Page 4, paragraph 2 of the Office action dated December 15, 2004). The Examiner also asserted that “[t]he hardware aspects of claim 6 are inherent in MS Word.” (Page 9, paragraph 4 of the Office action dated December 15, 2004). Applicants traverse this rejection, and assert that the Examiner has failed to establish a *prima facie* case of obviousness, because: (1) the MS Word Screen Dumps do not clearly disclose a device with a first help mode that provides for subsequent selection of icons without transmission of the corresponding command to the processor, (2) the MS Word Screen Dumps do not disclose a device that communicates instructions related to the function of an icon selectable with the first help mode; (3) the MS Word Screen Dumps do not teach or suggest modifying the MS Word “What’s This?” tool to include a link to command instructions related to the function of an icon selectable with the “What’s This?” tool, and (4) the Examiner has proposed a modification that changes the principle of operation of the “MS Word Help” tool.

The MS Word Screen Dumps do not clearly disclose a device with a user-selectable first help mode that “provides for subsequent selection of icons without transmission of the corresponding command to the processor,” as claimed in claim 6. As discussed with respect to claim 1, the MS Word Screen Dumps do not clearly show: (1) whether the pop-up windows shown in Figs. 2 and 3 of the MS Word Screen Dumps

provide a “short description,” that appears by hovering the cursor over the icon, or “a more detailed description” that appears by pressing the mouse button; (2) whether hovering over the icon, pressing the mouse button, or double-clicking the mouse button, thereafter disables the “What’s This?” tool and enables the icon, or (3) whether the icon’s function is, in fact, disabled after selecting the “What’s This?” tool. Therefore, the Examiner has failed to show a device with a help mode that provides for subsequent selection of icons without transmission of the corresponding command to a processor, and the rejection of claim 6 should be withdrawn.

The MS Word Screen Dumps also do not disclose a device that communicates instructions related to the function of an icon selectable with the first help mode, as claimed in claim 6. As discussed with respect to claim 1, Figs. 6-9 of the MS Word Screen Dumps show pop-up windows that include a search field, a search results field, and a help window. None of the help topics listed in Figs. 6-9 of the MS Word Screen Dumps appear to provide instructions related to icons identifiable via the “What’s This?” tool, let alone instructions related to any type of function associated with such icons. Therefore, the Examiner has failed to show a device that communicates instructions related to the function of an icon selectable with a first help mode, and the rejection of claim 6 should be withdrawn.

The MS Word Screen Dumps do not disclose a “help window including an identification of a function associated with the selected icon and a link to command instructions related to the function associated with the selected icon,” as claimed in claim 6. Even if the Examiner’s asserted functions of the “What’s This?” tool and “Microsoft Word Help” tool are accepted based on the MS Word Screen Dumps, the Examiner has explicitly recognized that the “MS Word ‘What’s This?’ tool does not

disclose a link to instructions related to accomplishing the function; and in response to user-selection of the link, displaying the instructions related to accomplishing the function." (Page 3, paragraph 2 of the Office action dated December 15, 2004). Further, applicants assert that there is no suggestion or motivation expressed in the cited art to modify the "What's This?" tool to include the function of the "Microsoft Word Help" tool, as discussed with respect to claim 1. The Examiner is using the applicants' disclosure as a template for modifying MS Word, and the rejection of claim 6 should therefore be withdrawn.

Even if the "What's This?" tool and the "MS Word Help" tool were combined in a single help window, which applicants maintain is improper, the combination would not result in a one-to-one relationship between (1) selection of an icon for identification of a function associated with an icon, and (2) instructions related to the function associated with the selected icon. Despite this incongruity, the Examiner has asserted that combining the "MS Word Help" tool and the "What's This?" tool "would result in a one-to-one relationship because the combination would allow the ["MS Word Help" tool] to open showing detailed instructions related to accomplishing the function associated with an icon." (Page 9, paragraph 2 of the Office action dated December 15, 2004). As discussed with respect to claim 1, the Examiner has improperly proposed a modification that changes the principle of operation of the "MS Word Help" tool by eliminating the search function that is currently provided by the "MS Word Help" tool. The Examiner again appears to be inappropriately using the applicants' disclosure as a template for modifying MS Word, and the rejection of claim 6 should be withdrawn.

As discussed above, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending from that claim is also nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, claims 7-8 are nonobvious because they depend from nonobvious claim 6.

4. Claims 14-15

Claim 14 recites a computer-implemented user interface, which includes plural icons, “each nominally selectable to invoke a function associated with the icon” and a help menu with a first help mode “selectable to provide for subsequent selection of one of the icons without invoking the function associated with the selected icon.” Claim 14 also includes a help window that includes “an identification of the function associated with the selected icon” and “a link to command instructions related to the function associated with the selected icon,” where the command instructions are “presented upon selection of the link.”

The Examiner indicated that claim 14 is “similar in scope to claim 1, and [is] therefore rejected under similar rationale.” (Page 4, paragraph 2 of the Office action dated December 15, 2004). Applicants traverse this rejection, and assert that the Examiner has failed to establish a *prima facie* case of obviousness, because: (1) the MS Word Screen Dumps do not clearly disclose a user interface with a first help mode selectable to provide for subsequent selection of one of the icons without invoking a function associated with the selected icon, (2) the MS Word Screen Dumps do not disclose command instructions related to the function associated with a selectable icon; (3) the MS Word Screen Dumps do not teach or suggest modifying the MS Word “What’s This?” tool to include a link to command instructions related to the function of an icon selectable with the “What’s This?” tool, and (4) the Examiner

has proposed a modification that changes the principle of operation of the “MS Word Help” tool.

The MS Word Screen Dumps do not clearly disclose a user interface with “a first help mode selectable to provide for subsequent selection of one of the icons without invoking a function associated with the selected icon,” as claimed in claim 14. As discussed with respect to claim 1, the MS Word Screen Dumps do not clearly show: (1) whether the pop-up windows shown in Figs. 2 and 3 of the MS Word Screen Dumps provide a “short description,” that appears by hovering the cursor over the icon, or “a more detailed description” that appears by pressing the mouse button; (2) whether hovering over the icon, pressing the mouse button, or double-clicking the mouse button, thereafter disables the “What’s This?” tool and enables the icon, or (3) whether the icon’s function is, in fact, disabled after pressing the “What’s This?” tool. Therefore, the Examiner has failed to show a help mode that allows a user to select an icon without invoking the icon’s function, and the rejection of claim 14 should be withdrawn.

The MS Word Screen Dumps also do not disclose command instructions related to the function associated with a selectable icon, as claimed in claim 14. As discussed with respect to claim 1, Figs. 6-9 of the MS Word Screen Dumps show pop-up windows that include a search field, a search results field, and a help window. None of the help topics listed in Figs. 6-9 of the MS Word Screen Dumps provide instructions related to icons identifiable via the “What’s This?” tool, let alone instructions related to any type of function associated with such icons. Therefore, the Examiner has failed to show command instructions related to the function associated with a selectable icon, and the rejection of claim 14 should be withdrawn.

The MS Word Screen Dumps do not disclose a “help window including an identification of the function associated with the selected icon and a link to command instructions related to the function associated with the selected icon,” as claimed in claim 14. Even if the Examiner’s asserted functions of the “What’s This?” tool and “Microsoft Word Help” tool are accepted based on the MS Word Screen Dumps, the Examiner has explicitly recognized that the “MS Word ‘What’s This?’ tool does not disclose a link to instructions related to accomplishing the function; and in response to user-selection of the link, displaying the instructions related to accomplishing the function.” (Page 3, paragraph 2 of the Office action dated December 15, 2004). Further, applicants assert that there is no suggestion or motivation expressed in the cited art to modify the “What’s This?” tool to include the function of the “Microsoft Word Help” tool, as discussed with respect to claim 1. Rather, the Examiner is using the applicants’ disclosure as a template for modifying MS Word. The rejection of claim 14 should therefore be withdrawn.

Even if the “What’s This?” tool and the “MS Word Help” tool were combined in a single help window, which applicants maintain is improper, the combination would not result in a one-to-one relationship between (1) identification of a function associated with a selected icon, and (2) instructions related to accomplishing the function associated with the selected icon. Despite this incongruity, the Examiner has asserted that combining the “MS Word Help” tool and the “What’s This?” tool “would result in a one-to-one relationship because the combination would allow the [“MS Word Help” tool] to open showing detailed instructions related to accomplishing the function associated with an icon.” (Page 9, paragraph 2 of the Office action dated December 15, 2004). As discussed with respect to claim 1, the Examiner has

improperly proposed a modification that changes the principle of operation of the “MS Word Help” tool by eliminating the search function that is currently provided by the “MS Word Help” tool. The Examiner again appears to be inappropriately using the applicants’ disclosure as a template for modifying MS Word, and the rejection of claim 14 should be withdrawn.

As discussed above, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending from that claim is also nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, claim 15 is nonobvious because it depends from nonobvious claim 14.

##### 5. Claims 21-23

Claim 21 recites a program storage device readable by a processor, tangibly embodying a program of instructions executable by the processor to perform a method for accessing instructions on a device having a user interface. The device includes a first help mode that “allows the user to choose an icon for identification of a function associated with the icon without invoking the function.” The device also includes a help window that identifies “a function associated with the icon” and includes “a link to instructions related to accomplishing the function,” where user-selection of the link displays the instructions related to accomplishing the function.

The Examiner indicated that claim 21 is “similar in scope to claim 1, and [is] therefore rejected under similar rationale.” (Page 4, paragraph 2 of the Office action dated December 15, 2004). Applicants traverse this rejection, and assert that the Examiner has failed to establish a *prima facie* case of obviousness, because: (1) the MS Word Screen Dumps do not clearly disclose a first help mode that allows a user to choose an icon for identification without invoking the function, (2) the MS Word Screen

Dumps do not disclose a device that displays instructions related to accomplishing the function of an icon identifiable selectable with the first help mode; (3) the MS Word Screen Dumps do not teach or suggest modifying the MS Word “What’s This?” tool to include a link to command instructions related to the function of an icon selectable with the “What’s This?” tool, and (4) the Examiner has proposed a modification that changes the principle of operation of the “MS Word Help” tool.

The MS Word Screen Dumps do not clearly disclose a first help mode that allows a user to choose an icon for identification of a function associated with the icon without invoking the function, as claimed in claim 21. As discussed with respect to claim 1, the MS Word Screen Dumps do not clearly show: (1) whether the pop-up windows shown in Figs. 2 and 3 of the MS Word Screen Dumps provide a “short description,” that appears by hovering the cursor over the icon, or “a more detailed description” that appears by pressing the mouse button; (2) whether hovering over the icon, pressing the mouse button, or double-clicking the mouse button, thereafter disables the “What’s This?” tool and enables the icon, or (3) whether the icon’s function is, in fact, disabled after pressing the “What’s This?” tool. Therefore, the Examiner has failed to show a device with a help mode that allows a user to choose an icon for identification of a function associated with the icon without invoking the function, and the rejection of claim 21 should be withdrawn.

The MS Word Screen Dumps also do not disclose a device that displays instructions related to accomplishing the function of an icon identifiable with the first help mode, as claimed in claim 21. As discussed with respect to claim 1, Figs. 6-9 of the MS Word Screen Dumps show pop-up windows that include a search field, a search results field, and a help window. None of the help topics listed in Figs. 6-9 of

the MS Word Screen Dumps appear to provide instructions related to icons identifiable via the “What’s This?” tool, let alone instructions related to any type of function associated with such icons. Therefore the MS Word Screen Dumps do not show a device that communicates instructions related to the function of an icon selectable with a first help mode, and the rejection of claim 21 should be withdrawn.

The MS Word Screen Dumps do not disclose a “help window including an identification of a function associated with the icon and a link to instructions related to accomplishing the function,” as claimed in claim 21. Even if the Examiner’s asserted functions of the “What’s This?” tool and “Microsoft Word Help” tool are accepted based on the MS Word Screen Dumps, the Examiner has explicitly recognized that the “MS Word ‘What’s This?’ tool does not disclose a link to instructions related to accomplishing the function; and in response to user-selection of the link, displaying the instructions related to accomplishing the function.” (Page 3, paragraph 2 of the Office action dated December 15, 2004). Further, applicants assert that there is no suggestion or motivation expressed in the cited art to modify the “What’s This?” tool to include the function of the “Microsoft Word Help” tool, as discussed with respect to claim 1. The Examiner is using the applicants’ disclosure as a template for modifying MS Word, and the rejection of claim 21 should therefore be withdrawn.

Even if the “What’s This?” tool and the “MS Word Help” tool were combined in a single help window, which applicants maintain is improper, the combination would not result in a one-to-one relationship between (1) selection of an icon for identification of a function associated with an icon, and (2) instructions related to accomplishing the function. Despite this incongruity, the Examiner has asserted that

combining the “MS Word Help” tool and the “What’s This?” tool “would result in a one-to-one relationship because the combination would allow the [“MS Word Help” tool] to open showing detailed instructions related to accomplishing the function associated with an icon.” (Page 9, paragraph 2 of the Office action dated December 15, 2004). As discussed with respect to claim 1, the Examiner has improperly proposed a modification that changes the principle of operation of the “MS Word Help” tool by eliminating the search function that is currently provided by the “MS Word Help” tool. The Examiner again appears to be inappropriately using the applicants’ disclosure as a template for modifying MS Word, and the rejection of claim 21 should be withdrawn.

As discussed above, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending from that claim is also nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, claims 22-23 are nonobvious because they depend from nonobvious claim 21.

***B. Rejection of Claims 9-13, and 16-20 under 35 U.S.C. § 103(a) as Being Unpatentable over the MS Word Screen Dumps in Combination with Fang is Inappropriate***

The Examiner rejected claims 9-13 and 16-20 as being obvious over the MS Word Screen Dumps in combination with Fang. Applicants assert that the Examiner has failed to establish the *prima facie* obviousness of claims 9-13 and 16-20.

***1. The Legal Standard***

As discussed above, obviousness is a question of law based on (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (US 1966). “In

proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art.” *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). “If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991).

## 2. Claims 9-13.

Claims 9-13 depend from claim 6, and are therefore drawn to devices that include a processor and a user interface with a help mode. The devices of claims 9-13 include “a copier,” “a printer,” “a fax machine,” “a digital sender,” and “a multi-function peripheral,” respectively. Because claims 9-13 depend from nonobvious claim 8, they are nonobvious for at least the same reasons stated with respect to claims 6-8 above.

Claims 9-13 were rejected as being obvious over the MS Word Screen Dumps in combination with Fang. In rejecting claims 9-13, the Examiner recognized

that "MS Word does not disclose the type of devices that can be used with this help system." (Page 6, paragraph 3 of the Office action dated December 15, 2005). The Examiner then asserted that:

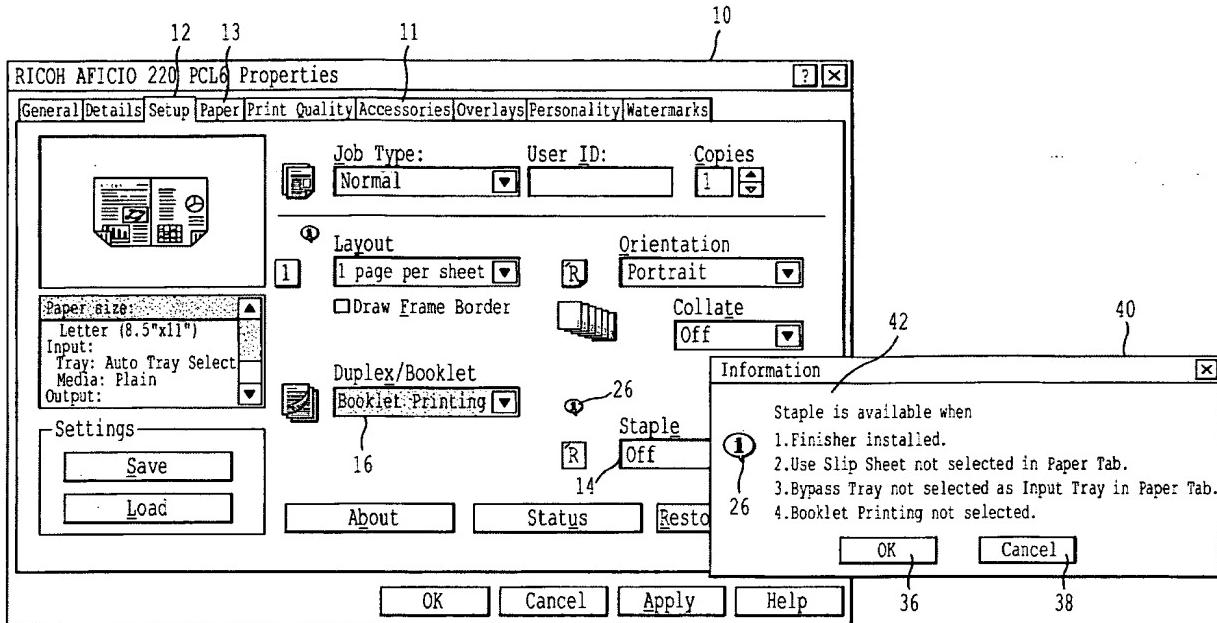
"Fang teaches that the device running a help system is an auxiliary device (column 1, lines 17-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of MS Word to include running a help system on a plurality of auxiliary devices, as taught by Fang, with the motivation to provide help on a plurality of devices that require user interaction." *Id.*

Applicants traverse this rejection, and assert that the Examiner has failed to establish a *prima facie* case of obviousness, because (1) Fang does not disclose an auxiliary device that runs a help system, and (2) there is no motivation or suggestion in the prior art as a whole to combine Fang with the MS Word help tools shown in the MS Word Screen Dumps.

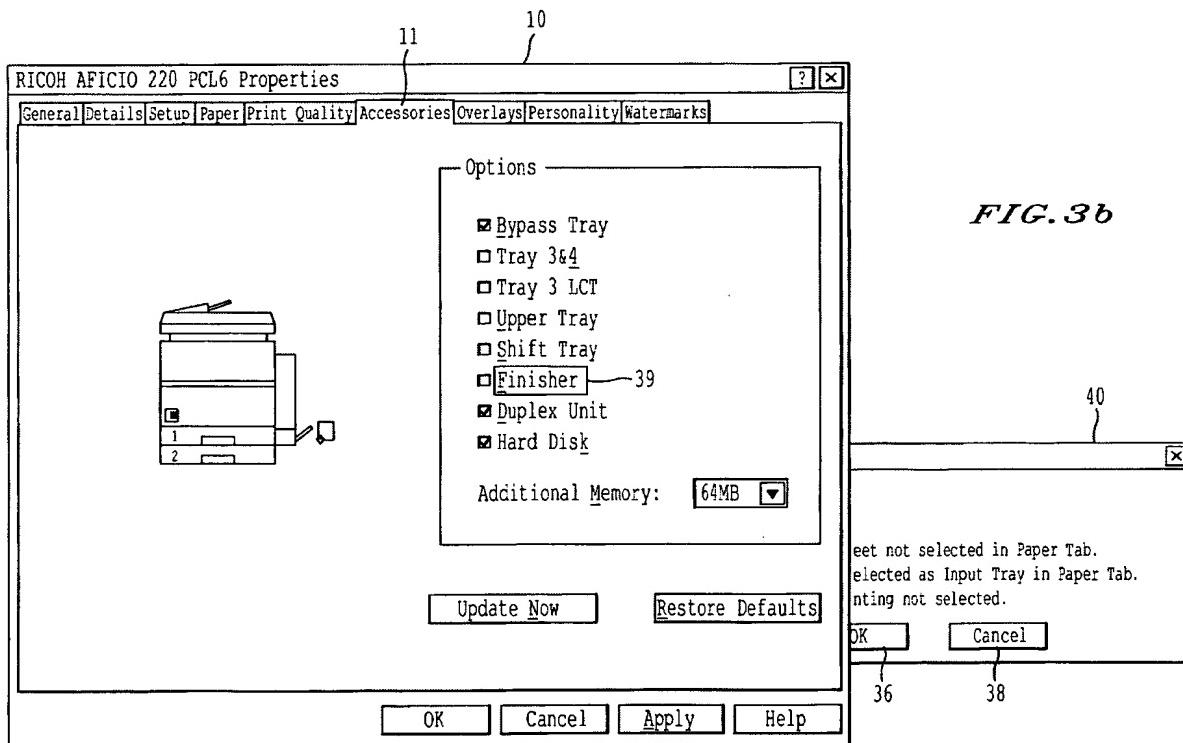
a) *Fang Does Not Disclose an Auxiliary Device that Runs a Help System*

Fang discloses "a Graphical User Interface (GUI) which includes embedded hyperlink help messages in a help message dialog box." (Column 2, lines 40-42). The GUI disclosed by Fang includes "a printer driver," "a scanner driver, facsimile driver, or a general computer application." (Column 4, lines 16-21). For example, Figs. 3a-b, shown below, illustrate a GUI for a printer driver.

**FIG. 3a**



**FIG. 3b**



The printer driver includes a printer properties dialog 10 having a plurality of selectable tabs, such as an Accessories tab 11, a Setup tab 12, and a Paper tab 13. (See Fig.

3a). The printer driver also includes a plurality of display controls, such as Duplex/Booklet display control 16, and Staple display control 14. (See Fig. 3a). These display controls are used to select printing options that are used by a computer to control an auxiliary printer, when the printer processes a print job. Fang discloses that “interdependencies generally exist among different display controls, which make certain display controls become unavailable to a user under certain conditions...To communicate this to the user, the respective display control is deactivated.” (Column 1, lines 34-42). For example, Fig. 3a shows the Staple display control 14 deactivated (i.e. the Staple display control is illustrated as “Off”). “A help icon 26 (which may be displayed as a balloon-shaped help sign) is also displayed near the deactivated display control. Thus, the user may select the help icon 26 to retrieve information about the deactivated Staple display control 14.” (Column 1, lines 43-47). When help icon 26 is selected, a message dialog box 40 appears including embedded hyperlink help messages 42 that provide a number of reasons why a deactivated display control is deactivated. (Column 3, lines 44-47, and Fig. 3a). Each of these reasons includes a selectable hyperlink. (Column 3, lines 48-65). When a user selects one of the hyperlinks (such as “Finisher installed,” shown in Fig 3a), the printer driver executes a computer program that identifies and displays the appropriate tab (such as the Accessories tab 13, shown in Fig. 3b) and highlights the appropriate display control (such as the “Finisher” display control 39, shown in Fig. 3b) corresponding to the reason why the deactivated display control is deactivated. *Id.* A user may then choose to remedy the reason that the deactivated display control is deactivated.

Fang therefore discloses a GUI that includes embedded hyperlinked help messages that facilitate navigation of the GUI such that a user can easily identify

and remedy reasons that a deactivated display control is deactivated. However, Fang does not teach that the hyperlinked help messages are run on “a copier,” “a printer,” “a fax machine,” “a digital sender,” or “a multi-function peripheral.” Rather, Fang explicitly provides “a method of controlling an *auxiliary* device, such as a printer, through a graphical user interface according to the present invention.” (Column 4, lines 57-59, and Fig. 5). Fang also explicitly states that the GUI corresponds “to a graphical user interface for a printer *driver*. However, the present invention is not limited to a printer *driver* GUI. That is, the present invention also relates to a GUI for a scanner *driver*, facsimile *driver*, or a general *computer* application.” (Column 4, lines 16-21, emphasis added). A “driver” is defined in-part as:

“Computer Science. A piece of software that enables a computer to communicate with a peripheral device.” (*The American Heritage® Dictionary of the English Language, Fourth Edition*).

Thus, the GUI disclosed by Fang is software run by a computer that enables the computer to communicate with and control a device peripherally attached to a computer. A computer would require a different device driver for each device that is connected to the computer. Because the GUI, and therefore the computer onto which the GUI is loaded, runs the embedded hyperlinked help messages, Fang does not disclose peripheral devices that run help systems by themselves.

In contrast, claims 9-13 respectively claim “a copier,” “a printer,” “a fax machine,” “a digital sender,” and a “multi-function peripheral” with a processor and a user interface that includes a help mode. While these devices may be considered peripheral devices, in that they are connectable to computers, they include their own processors and user interfaces that are separate from any computer. A user may interface with the device through the device’s user interface, and without the use of a

computer configured with the necessary device driver. More importantly, the help mode included in the peripheral device is run by the device itself. Therefore, GUI disclosed in Fang is distinguishable from the device claimed in claims 9-13, and the rejection of those claims should be withdrawn.

*b) There Is No Motivation or Suggestion in the Prior Art as a Whole to Combine Fang with the Help Tools Disclosed in the MS Word Screen Dumps.*

The Examiner has not factually supported a *prima facie* conclusion of obviousness because the Examiner has not identified a proper motivation or suggestion to combine the MS Word Screen Dumps with Fang. Instead, the Examiner concludes without factual support that "Fang teaches that the device running a help system is an auxiliary device (column 1, lines 17-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of MS Word to include running a help system on a plurality of auxiliary devices, as taught by Fang, with the motivation to provide help on a plurality of devices that require user interaction." (Page 6, paragraph 3 of the Office action dated December 15, 2005).

In this statement, the Examiner suggests that the motivation to combine Fang with the MS Word help tools disclosed in the MS Word Screen Dumps is derived from the desire to run help systems on a plurality of auxiliary devices that require user interaction. As discussed above, however, neither the MS Word Screen Dumps nor Fang discloses running help systems on a plurality of auxiliary devices. Rather, the MS Word Help tools and the Fang help system are run on computers that in turn are running MS Word and device drivers, respectively. The Examiner apparently is using the applicants' disclosure, which does describes the desire to provide help

tools that run on peripheral devices, as a template for combining Fang with the MS Word help tools disclosed in the MS Word Screen Dumps. This is inappropriate because the motivation or suggestion to make the claimed combination can not come from the disclosure of the applicant. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Furthermore, there is no motivation or suggestion to combine references if the proposed combination changes the principle of operation of a reference. *In re Ratti*, 270 F.2d 810 (CCPA 1959). In this case, the MS Word Help tools disclosed in the MS Word Screen Dumps, and the help system disclosed in Fang provide completely different functionality such that: (1) combining the MS Word help tools with the GUI disclosed in Fang would change the principle of operation of the GUI; and (2) combining the Fang help system with MS Word would change the principle of operation of MS Word.

*(1) Combining the MS Word Help Tools With the GUI Disclosed in Fang Would Change the Principle of Operation of the GUI.*

As described above, the MS Word help tools include a “What’s This?” tool and a “MS Word Help” tool. The “What’s This?” tool identifies an icon used in word processing programs. The “MS Word Help” tool provides a pop-up window that includes: (1) a search field into which a user may enter a search term related to a word processing task they would like to perform; (2) a search results field that provides a list of topics related to the search term from which the user may select a particular topic; and (3) a help window that displays subtopics related to the selected topic, or displays instructions related to the selected topic with links to additional instructions related to the selected topic.

Also as described above, the GUI disclosed in Fang is an auxiliary device driver that includes a properties dialog with a plurality of selectable tabs and a plurality of

display controls. The display controls are used to select device options that are sent by the computer to the attached device. Interdependencies exist between different display controls, which cause certain display controls to be deactivated. For example, if a first display control is deactivated, then the setting associated with a second display control may be responsible for deactivating the first display control. The GUI's help system uses hyperlinked help messages embedded in help dialog boxes that link a user to the appropriate tab that includes the second display control. The help system also highlights the second display control so that the user can easily find the reason for which the first display control is deactivated. As described in the background section of Fang, a printer driver that does **not** include hyperlinked help messages, requires a user:

“to have a general knowledge of the different tabs associated with a print properties dialog. Further the user is prevented from selecting another tab of the printer properties dialog until the help message dialog box is closed (e.g., by selecting the OK push button or Cancel push button). Thus, many situations occur in which the user closes the help message dialog box, selects another tab (Such as the Paper tab), but forgets which display control in the Paper tab was identified in the help information...Therefore, a user may have to repeat the above steps several times to accurately determine all of the reasons why the staple display control is deactivated.” (Column 2, lines 4-20).

Fang explicitly states that “one object of the present invention is to solve the above-noted in-efficiency in using the Help dialog box.” (Column 2, lines 36-38).

Combining the MS Word help tools with the GUI disclosed in Fang changes the principle of operation of the GUI. Even if the MS Word help tools are modified by combining the “What's This?” tool with the “MS Word Help” tool, which applicants maintain is improper, the MS Word help tools do not include: (1) help icons that appear near a display control when the display control is deactivated; (2) hyperlink messages that provide reasons why a deactivated display control is deactivated; and (3) a computer program that identifies and displays tabs and highlights the display controls

corresponding to the reason why the deactivated display control is deactivated. Therefore, replacing the Fang help system with the MS Word help tools would remove the functionality of the Fang help tools, and change the principle of operation of the GUI. Further, merely adding the MS Word help tools to a GUI with the Fang help system also completely changes the manner in which the Fang help system operates, by providing drop down menus, a “What’s This?” tool that identifies icons, and a help tool that provides subtopics, and information with links to additional information. None of the functions provided by the MS Word help tools would enable a user to identify and display the tabs, or highlight the display controls, corresponding to a reason why a deactivated display control is deactivated. In fact, even if the MS Word help tools did provide instructions on how to identify and display tabs and display controls, the MS Word help tools would do so in a separate help window that would require a user “to have a general knowledge of the different tabs associated with a print properties dialog,” and would prevent the user “from selecting another tab of the printer properties dialog” until the MS Word help tools were closed. As discussed above, Fang explicitly teaches away from such a help system. For at least these additional reasons, the combination of the MS Word help tools with the GUI disclosed in Fang is therefore inappropriate, and the rejection of claims 9-13 should be reversed.

*(2) Combining the Fang Help System with MS Word Would Render MS Word Unsatisfactory For its Intended Purpose.*

As described above, the GUI disclosed in Fang is an auxiliary device driver that includes a plurality of tabs and display controls that are interdependent upon one another. The auxiliary device driver also includes a help system with help icons that appear near a display control when the display control is deactivated. When a user selects the help icon, a message dialog box appears that includes embedded hyperlink

help messages that provide a number of reasons why a deactivated display control is deactivated. When a user selects one of the hyperlinks, the GUI executes a computer program that identifies and displays the appropriate tab and highlights the appropriate display control corresponding to the reason why the deactivated display control is deactivated. A user may then remedy the reason that the deactivated display control is deactivated.

As understood from the MS Word Screen Dumps, MS Word is a word processing program that does not include tabs, and uses icons instead of display controls. Interdependencies do not exist between different icons, such that by activating a first icon, a second icon may be deactivated. Also, the MS Word Screen Dumps do not show any help icons, let alone help icons that appear or disappear when anything in MS Word is selected or deselected. Instead, MS Word provides a "What's This?" tool and a "MS Word Help" tool. The "What's This?" tool identifies an icon used in word processing programs. The "MS Word Help" tool provides a pop-up window that includes: (1) a search field into which a user may enter a search term related to a word processing task they would like to perform; (2) a search results field that provides a list of topics related to the search term from which the user may select a particular topic; and (3) a help window that displays subtopics related to the selected topic, or displays instructions related to the selected topic with links to additional instructions related to the selected topic.

Combining the Fang help system with MS Word changes the principle of operation of MS Word. Specifically, MS Word does not include tabs or display controls, such that including the Fang help system in MS Word would not provide any added functionality whatsoever. Further, including interrelated tabs and display

controls in MS Word would completely change the user interface of MS Word. For at least these additional reasons, the combination of the Fang help system with MS Word is therefore inappropriate, and the rejection of claims 9-13 should be reversed.

3. Claims 16-20.

Claims 16-20 depend from claim 14, and are therefore drawn to computer-implemented user interfaces that are configured to operate “a copier,” “a printer,” “a fax machine,” “a digital sender,” and “a multi-function peripheral,” respectively. Because claims 16-20 depend from nonobvious claim 14, they are nonobvious for at least the same reasons stated with respect to claims 14-15 above.

Claims 16-20 were rejected as being obvious over the MS Word Screen Dumps in combination with Fang. In rejecting claims 16-20, the Examiner asserted that they are “similar in scope to claims 9-13, respectively, and are therefore rejected under similar rationale.” While it is true that claims 16-20 recite a user interface with a help mode, as well as various forms of peripheral devices, applicants note that claims 16-20 are, in fact, different from claims 9-13 and are thus worthy of separate treatment. Specifically, claims 16-20 recite a computer-implemented user interfaces with a help mode, where the user-interfaces are configured to operate specific peripheral devices. The help mode of claims 16-20 therefore could be run on either a computer or the peripheral device itself. In contrast, claims 9-13 recite peripheral devices that include a processor, and a user interface with a help mode. As discussed above, these devices include their own processors and user interfaces that are separate from any computer, such that the help mode is run by the device itself. Therefore, claims 16-20 are worthy of separate treatment from claims 9-13.

Applicants traverse the rejection of claims 16-20, and assert that the Examiner has failed to establish a *prima facie* case of obviousness, because there is no motivation or suggestion in the prior art as a whole to combine Fang with the MS Word help tools shown in the MS Word Screen Dumps. Specifically, there is no motivation or suggestion to combine references if the proposed combination changes the principle of operation of a reference. *In re Ratti*, 270 F.2d 810 (CCPA 1959). In this case, the MS Word Help tools disclosed in the MS Word Screen Dumps, and the help system disclosed in Fang provide completely different functionality such that: (1) combining the MS Word help tools with the GUI disclosed in Fang would change the principle of operation of the GUI; and (2) combining the Fang help system with MS Word would change the principle of operation of MS Word.

a) *Combining the MS Word Help Tools With the GUI Disclosed in Fang Would Change the Principle of Operation of the GUI.*

As described above, the MS Word help tools include a “What’s This?” tool and a “MS Word Help” tool. The “What’s This?” tool identifies an icon used in word processing programs. The “MS Word Help” tool provides a pop-up window that includes: (1) a search field into which a user may enter a search term related to a word processing task they would like to perform; (2) a search results field that provides a list of topics related to the search term from which the user may select a particular topic; and (3) a help window that displays subtopics related to the selected topic, or displays instructions related to the selected topic with links to additional instructions related to the selected topic.

Also as described above, the GUI disclosed in Fang is an auxiliary device driver that includes a properties dialog with a plurality of selectable tabs and a plurality of

display controls. The display controls are used to select device options that are sent by the computer to the attached device. Interdependencies exist between different display controls, which cause certain display controls to be deactivated. For example, if a first display control is deactivated, then the setting associated with a second display control may be responsible for deactivating the first display control. The GUI's help system uses hyperlinked help messages embedded in help dialog boxes that link a user to the appropriate tab that includes the second display control. The help system also highlights the second display control so that the user can easily find the reason for which the first display control is deactivated. As described in the background section of Fang, a printer driver that does **not** include hyperlinked help messages, requires a user:

“to have a general knowledge of the different tabs associated with a print properties dialog. Further the user is prevented from selecting another tab of the printer properties dialog until the help message dialog box is closed (e.g., by selecting the OK push button or Cancel push button). Thus, many situations occur in which the user closes the help message dialog box, selects another tab (Such as the Paper tab), but forgets which display control in the Paper tab was identified in the help information...Therefore, a user may have to repeat the above steps several times to accurately determine all of the reasons why the staple display control is deactivated.” (Column 2, lines 4-20).

Fang explicitly states that “one object of the present invention is to solve the above-noted in-efficiency in using the Help dialog box.” (Column 2, lines 36-38).

Combining the MS Word help tools with the GUI disclosed in Fang changes the principle of operation of the GUI. Even if the MS Word help tools are modified by combining the “What's This?” tool with the “MS Word Help” tool, which applicants maintain is improper, the MS Word help tools do not include: (1) help icons that appear near a display control when the display control is deactivated; (2) hyperlink messages that provide reasons why a deactivated display control is deactivated; and (3) a computer program that identifies and displays tabs and highlights the display controls

corresponding to the reason why the deactivated display control is deactivated. Therefore, replacing the Fang help system with the MS Word help tools would remove the functionality of the Fang help tools, and change the principle of operation of the GUI. Further, adding the MS Word help tools to a GUI with the Fang help system also completely changes the manner in which the Fang help system operates, by providing drop down menus, a “What’s This?” tool that identifies icons, and a help tool that provides subtopics, and information with links to additional information. None of the functions provided by the MS Word help tools would enable a user to identify and display the tabs, and highlight the display controls, corresponding to a reason why a deactivated display control is deactivated. In fact, even if the MS Word help tools did provide instruction on how to identify and display tabs and display controls, the MS Word help tools would do so in a separate help window that would require a user “to have a general knowledge of the different tabs associated with a print properties dialog,” and would prevent the user “from selecting another tab of the printer properties dialog” until the MS Word help tools were closed. As discussed above, Fang explicitly teaches away from such a help system. For at least these additional reasons, the combination of the MS Word help tools with the GUI disclosed in Fang is therefore inappropriate, and the rejection of claims 16-20 should be reversed.

*b) Combining the Fang Help System with MS Word Would Render MS Word Unsatisfactory For its Intended Purpose.*

As described above, the GUI disclosed in Fang is an auxiliary device driver that includes a plurality of tabs and display controls that are interdependent upon one another. The auxiliary device driver also includes a help system with help icon that appear near a display control when the display control is deactivated. When a user selects the help icon, a message dialog box appears that includes embedded hyperlink

help messages that provide a number of reasons why a deactivated display control is deactivated. When a user selects one of the hyperlinks, the GUI executes a computer program that identifies and displays the appropriate tab and highlights the appropriate display control corresponding to the reason why the deactivated display control is deactivated. A user may then remedy the reason that the deactivated display control is deactivated.

As understood from the MS Word Screen Dumps, MS Word is a word processing program that does not include tabs, and uses icons instead of display controls. Interdependencies do not exist between different icons, such that by activating a first icon a second icon may be deactivated. Also, the MS Word Screen Dumps do not show any help icons, let alone help icons that appear or disappear when anything in MS Word is selected or deselected. Instead, MS Word provides a "What's This?" tool and a "MS Word Help" tool. The "What's This?" tool identifies an icon used in word processing programs. The "MS Word Help" tool provides a pop-up window that includes: (1) a search field into which a user may enter a search term related to a word processing task they would like to perform; (2) a search results field that provides a list of topics related to the search term from which the user may select a particular topic; and (3) a help window that displays subtopics related to the selected topic, or displays instructions related to the selected topic with links to additional instructions related to the selected topic.

Combining the Fang help system with MS Word changes the principle of operation of MS Word. Specifically, MS Word does not include tabs or display controls, such that including the Fang help system in MS Word would not provide any added functionality whatsoever. Further, including interrelated tabs and display

controls in MS Word would completely change the user interface of MS Word. For at least these additional reasons, the combination of the Fang help system with MS Word is therefore inappropriate, and the rejection of claims 16-20 should be reversed.

*C. Conclusion*

The rejection of claims 1-23 is improper because claims 1-8, 14-15 and 21-23 are not obvious in view of the MS Word Screen Dumps (pages 1-5), and claims 9-13 and 16-20 are not obvious in view of the MS Word Screen Dumps in view of Fang. Accordingly, the rejection of all pending claims should be reversed.

**VIII. CLAIMS APPENDIX**

1. A method for accessing instructions on a device having a user interface, the method comprising the steps of:

receiving a user-selection of a first help mode displayed on the user interface, the selected first help mode allowing the user to choose an icon for identification of a function associated with the icon without invoking the function;

upon receiving a user-selection of the icon, displaying a help window including an identification of a function associated with the icon and a link to instructions related to accomplishing the function; and

in response to user-selection of the link, displaying the instructions related to accomplishing the function.

2. The method of claim 1, which further comprises:

returning to the first help mode on the user interface after displaying the instructions;

receiving a next selection of a different icon;

displaying a different help window including an identification of a next function associated with the different icon and a next link to instructions related to accomplishing the next function; and

in response to user-selection of the next link, displaying instructions related to accomplishing the next function.

3. The method of claim 1, wherein the identification of a function associated with the icon includes a description of the function.

4. The method of claim 1, wherein the instructions related to accomplishing the function include a series of steps a user executes to accomplish a task associated with the function.

5. The method of claim 1, further comprising the steps of:

receiving a user-selection of a second help mode displayed on the interface, the second help mode presenting a user with a list of help topics;

receiving a user-selection for a help topic from the list; and

displaying instructions for accomplishing a function related to the user-selected help topic.

6. A device configured to perform one or more user-selectable functions, the device comprising:

a processor configured to nominally effect a function upon receiving a command associated with the function; and

a user interface including a plurality of selectable icons, selection of each icon nominally effecting transmission of a corresponding command to the processor, the user interface further including a help menu having a user-selectable first help mode which provides for subsequent selection of icons without transmission of the corresponding command to the processor, and a help window presented upon selection of an icon after selection of the first help mode, the help window including an identification of a function associated with the selected icon and a link to command instructions related to the function associated with the selected icon, selection of the link effecting communication of the instructions.

7. The device of claim 6, further comprising a user-selectable second help mode, which upon selection, presents the user with a list of help topics from which the user selects a topic, wherein upon selection of a topic a set of instructions associated with the selected topic is displayed.

8. The device of claim 7, wherein the user interface includes a touch screen, which accommodates user-selection of the help menu and subsequently user-selection of either of the first help mode and the second help mode.

9. The device of claim 8, wherein the device is a copier.

10. The device of claim 8, wherein the device is a printer.

11. The device of claim 8, wherein the device is a fax machine.
  12. The device of claim 8, wherein the device is a digital sender.
  13. The device of claim 8, wherein the device is a multi-function peripheral
  14. A computer-implemented user interface comprising:
    - plural icons, each nominally selectable to invoke a function associated with the icon;
    - a help menu including a first help mode selectable to provide for subsequent selection of one of the icons without invoking the function associated with the selected icon;
    - a help window presented upon selection of the first help mode and subsequent selection of the selected icon, the help window including an identification of the function associated with the selected icon and a link to command instructions related to the function associated with the selected icon; and
    - command instructions presented upon selection of the link.
15. The interface of claim 14, wherein the help menu includes a second help mode configured to presents a list of selectable help topics, which upon selection of one of the help topics presents instructions related to the selected topic.
  16. The interface of claim 15, wherein interface is configured to operate a printer.
  17. The interface of claim 15, wherein the interface is configured to operate a copier.

18. The interface of claim 15, wherein the interface is configured to operate a fax machine.

19. The interface of claim 15, wherein the interface is configured to operate a digital sender.

20. The interface of claim 15, wherein the interface is configured to operate a multi-function peripheral.

21. A program storage device readable by a processor, tangibly embodying a program of instructions executable by the processor to perform method steps for accessing instructions on a device having a user interface, the method steps comprising:

receiving a user-selection of a first help mode displayed on the user interface, the selected first help mode allowing the user to choose an icon for identification of a function associated with the icon without invoking the function;

upon receiving a user-selection of the icon, displaying a help window including an identification of a function associated with the icon and a link to instructions related to accomplishing the function; and

in response to user-selection of the link, displaying the instructions related to accomplishing the function.

22. The program storage device of claim 21, wherein the method further comprises:

returning to the first help mode on the user interface after displaying the instructions,

receiving a next selection of a different icon;

displaying a different help window including an identification of a next function associated with the different icon and a next link to instructions related to accomplishing the next function; and

in response to user-selection of the next link, displaying instructions related to accomplishing the next function.

23. The program storage device of claim 21, wherein the method further comprises:

receiving a user-selection of a second help mode displayed on the interface, the second help mode presenting a user with a list of help topics;

receiving a user-selection for a help topic from the list; and

displaying instructions for accomplishing a function related to the user-selected help topic.

**IX. EVIDENCE APPENDIX**

None presented.

**X. RELATED PROCEEDINGS APPENDIX**

None presented.

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Christie Doolittle

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